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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,927

04/05/2004

Marko Kokko

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7590

10/29/2008

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8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

KING, SIMON

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,927	<b>Applicant(s)</b> KOKKO ET AL.	
	<b>Examiner</b> SIMON KING	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 47-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/13/2004 and 6/9/2005</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restrictions***

1. Applicant's election with traverse of Invention I, claims 1-37 in the reply filed on 7/18/2008 is acknowledged. Upon further review, Invention I (claims 1-37) and Invention II (claims 38-46) will be examined in the set forth office action. However, Invention III, claims 47-63, drawn to terminal device programmed to operate in response to automatic call response server for providing function such as voice mail service. This is not found persuasive because a terminal device by itself is a complete separate entity. Even though the terminal device's functionality is related to call response server for providing voice mail service, by itself is classified in a different class and subclass category.

***Claim Rejections - 35 USC § 112***

2. Claim 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As for claim 13, the cited claim as "... comprising checking the information i before authorizing...". "information i" was not defined in the dependent claims nor in the specification. Examiner will view this as a typo and claim 13 shall be interpreted as ".....comprising checking the information before authorizing..." Corrective action is required.

***Allowable Subject Matter***

Claims 31 and 42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 102, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: As for claim 31, prior art fails to teach a system wherein the server comprises means for removing the application specific content before

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storing the response content of the media message. As for claim 42, prior art fails to teach a server wherein the media message sent to the server includes application specific content, and the server further comprises means for processing the application specific content, and means for removing the application specific content before storing the response content of the media message.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-30, 32-41 and 43-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaddha et al. (US 2005/0020250 A1. Provisional Application No. 60/472,989, filed on May 23, 2003. Provisional Application No. 60/472,990, filed on May 23, 2003. Provisional Application No. 60/472,994, filed on May 23, 2003. Provisional Application No. 60/510,214, filed on Oct 9, 2003. Provisional Application No. 60/520,471, filed on Nov. 13, 2003.)

As for claim 1, Chaddha discloses a method (title) for providing a call response function in a communication network which includes a response server, having a storing means, the method comprising the steps of: a) providing, in a terminal of a user, a media message which includes response content; b) transmitting the media message from the

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terminal to the response server; and c) storing the response content of the media message in the storing means of the response server (Fig.2: [0028]).

As for claim 2, Chaddha discloses a method, further comprising the steps of: d) forwarding one of a call and a session request from another terminal directed to the user of the terminal, to the response server; and e) playing one of the response content and a part of the response content as a voice mail announcement to the another terminal ([0028] and [0036]).

As for claim 3, Chaddha discloses a method, wherein the step of providing the media message comprises providing a Multimedia Messaging Service (MMS) message ([0038]: MMS).

As for claim 5, Chaddha discloses a method, further comprising the steps of: forwarding one of a call and a session request from another terminal directed to the user of terminal to the server, and transmitting one of the stored response content and a part of the stored response content to the another terminal in a response media message ([0028] and [0036]).

As for claim 6, Chaddha discloses a method, further comprising the steps of: forwarding one of a call and a session request from another terminal directed to the user of terminal to the server; checking a media capability of the another terminal; and transmitting one of the stored response content and a part of the stored response content to the another terminal in a response media message when detecting that the another terminal has media capability (Abstract: [0033] and [0038]).

As for claim 7, Chaddha discloses a method, wherein one of the stored response content and the part of the stored response content is additionally played to the another terminal as a voice mail announcement ([0036]).

As for claim 8, Chaddha discloses a method, wherein the transmitted response content includes at least one of audio content, a picture and a video clip ([0044]).

As for claim 9, Chaddha discloses a method, wherein the step of transmitting one of the stored response content and the part of the stored response content in the response media message comprises transmitting one of a Multimedia Messaging Service (MMS) message and a Session Initiation Protocol (SIP) message ([0038] and [0046]: MMS protocol).

As for claim 10, Chaddha discloses a method, wherein the step of transmitting the media message comprises transmitting application specific content ([0044]).

As for claim 11, Chaddha discloses a method, wherein the application specific content is used to program a call response ([0044]: voice messages).

As for claim 12, Chaddha discloses a method, wherein the application specific content includes information for authentication of a sender of the media message ([0033]).

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As for claim 13, Chaddha discloses a method, further comprising checking the information before authorizing programming of the call response ([0031]).

As for claim 14, Chaddha discloses a method, wherein the information comprises at least a Personal Identification Number (PIN) code for authentication and authorization ([0031]).

As for claim 15, Chaddha discloses a method, wherein the application specific content includes at least one parameter of: a time of a call; control information for network provided information/assisted operation; different messages based on callee's location; and a validity time of the instructions; wherein the parameters allow different responses to be one of played to different callers and played at different calling times ([0035]).

As for claim 16, Chaddha discloses a method, further comprising: providing several different media messages, with different audio contents, in the terminal; selecting at least one of the provided media messages; and transmitting and processing the at least one selected media messages ([0029]: unique access phone number assign to each voice message).

As for claim 17, Chaddha discloses a method, wherein the media message comprises caller identification information, and the method further comprises storing the response content of the media message in the storing means of the server, and associating the response content with the user of the terminal and with caller identification information ([0028] and [0031]).

As for claim 18, Chaddha discloses a method, further comprising storing at least two response contents associated with the same user of the terminal and to different caller identification information on the server ([0032]: send different messages data files to more than one intended recipients).

As for claim 19, Chaddha discloses a method, wherein, when the one of the call and the session request of another terminal directed to the user of the terminal is forwarded to the server, the server detects a caller identification information of the caller, and one of plays the stored response content to the another terminal, and responds with a media message comprising the stored response content, and wherein the response content is associated with the user of the terminal and with detected caller identification information corresponding to the caller ([0028-0031]).

As for claim 20, Chaddha discloses a method, wherein the step of providing the media message in the terminal comprises providing the media message in a mobile terminal ([0017]).

As for claim 21, Method according to any one of the preceding claims claim 1, wherein the server is implemented in a Multimedia Messaging Service (MMS) center (MMSC) ([0038]: message server process MMS protocol).

As for claim 22, Chaddha discloses a system (title) for providing a call response function, in a communication network which includes a response server, having a storing means, comprising: a) a terminal configured to provide a media message which includes



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response content; and b) transmitting means for transmitting the media message from the terminal to the server; wherein the system is configured to store the response content of the media message in the storing means of the server (Fig.2: [0028]).

As for claim 23, Chaddha discloses a System, wherein the system is configured to play one of the response content and a part of the response content to another terminal as a voice mail announcement when one of a call and a session request of the another terminal directed to the terminal is forwarded to the server ([0028] and [0036]).

As for claim 24, Chaddha discloses a System, further comprising: means for transmitting one of the stored response content and at least part of the stored response content in a new media message to the another terminal ([0028] and [0036]).

As for claim 25, Chaddha discloses a System, further comprising: means for checking a media capability of the another terminal; and means for transmitting one of the stored response content and at least part of the stored response content in a new media message to the another terminal when the means for checking determines that the another terminal has media capability (Abstract: [0033] and [0038]).

As for claim 26, Chaddha discloses a System, wherein several different media messages, including Multimedia Messaging Service (MMS) messages with different response contents, are provided in the terminal, at least one of the provided media messages are selected by the terminal, and the at least one of the selected media message are transmitted and processed in the server ([0040]: sender may indicate the recipient or recipients of the data files using the sender device).

As for claim 27, Chaddha discloses a System, wherein the media message includes caller identification information indicating a caller of one of a call and a session forwarded to the server, and wherein the storing means stores the response content of the media message in the storing means of the server associated with the terminal and with the caller identification information ([0028] and [0036]).

As for claim 28, Chaddha discloses a System, wherein the server stores at least two response contents associated with a same terminal or a same user of the same terminal, and with different caller identification information ([0032-0033]).

As for claim 29, Chaddha discloses a System, wherein the server is configured to detect, when a call or a session request of another terminal directed to the terminal is forwarded to the server, caller identification information indicating a caller of the call or the session forwarded to the server, and to play or transmit, to the another terminal, the stored response content which is associated with the terminal and with the detected caller identification information ([0033])

As for claim 30, Chaddha discloses a System, wherein the media message sent to the server includes application specific content ([0044]).

As for claim 32, Chaddha discloses a System, wherein the application specific content includes authentication information indicating authentication of a sender of the media message to program a call response ([0033]).

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As for claim 33, Chaddha discloses a System, wherein the authentication information comprises at least a Personal Identification Number (PIN) code ([0031]).

As for claim 34, Chaddha discloses a System, wherein the authentication information is checked before programming the call response ([0031]).

As for claim 35, Chaddha discloses a System, wherein the application specific content includes at least one parameter of: a time of a call; control information for network provided information/assisted operation; different messages based on callee's location; and a validity time of the instructions; wherein the parameters allow different responses to be played to different callers and at different calling times ([0035]).

As for claim 36, Chaddha discloses a System, wherein the terminal is a mobile terminal ([0017]).

As for claim 37, Chaddha discloses a System, wherein the server is implemented in a Multimedia Messaging Service (MMS) center (MMSC) ([0038]: message server process MMS protocol).

As for claim 38, Chaddha discloses an automatic call response server, comprising: a storing means; and means for receiving, from a terminal, a media message which includes response content; wherein the response server is configured to process the media message to derive the response content, and to store the derived response content of the media message in the storing means of the response server (Fig.2: [0028]: Fig.4 and Fig.8: [0038] and [0050]).

As for claim 39, Chaddha discloses a Server, wherein the server is configured to play, when one of a call and a session request of another terminal directed to the terminal is forwarded to the server, one of the response content and at least a part of the response content to the another terminal as a voice mail announcement ([0028] and [0036]).

As for claim 40, Chaddha discloses a Server, further comprising means for generating and transmitting the media message comprising one of the stored response content and at least a part of the response content to the another terminal ([0028] and [0036]).

As for claim 41, Chaddha discloses a Server, further comprising means for checking a media capability of the another terminal, and means for generating and transmitting the media message comprising one of the stored response content and at least a part of the response content to the another terminal when means for checking detects that the another terminal has media capability (Abstract: [0033] and [0038]).

As for claim 43, Chaddha discloses a Server, wherein the server is implemented in a Multimedia Messaging Service (MMS) center (MMSC) ([0038]: MMS).

As for claim 44, Chaddha discloses a Server, wherein the media message includes caller identification information indicating one of a caller of a call and a session directed to the server, and wherein the server is configured to store the response

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content of the media message in the storing means of the server associated with the caller identification information ([0028] and [0031]).

As for claim 45, Chaddha discloses a Server, wherein the server is configured to store at least two response contents associated to a same terminal, or a user of the same terminal, and to different caller identification information ([0032-0033]).

As for claim 46, Chaddha discloses a Server, wherein the server is configured to detect, when one of a call and a session request of another terminal directed to the terminal is forwarded to the server, a caller identification information indicating a caller of one of a call and the session forwarded to the server, and to transmit or play, to the another terminal, the stored response content which is associated with the terminal and with the detected caller identification information ([0033]).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chaddha et al. (US 2005/0020250 A1. Provisional Application No. 60/472,989, filed on May 23, 2003. Provisional Application No. 60/472,990, filed on May 23, 2003. Provisional Application No. 60/472,994, filed on May 23, 2003. Provisional Application No.

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60/510,214, filed on Oct 9, 2003. Provisional Application No. 60/520,471, filed on Nov. 13, 2003.).

As for claim 4, Chaddha discloses the method for providing the media message. Chaddha discloses the claimed invention except wherein comprises providing a Session Initiation Protocol (SIP) message.

However, examiner take official notice that using Session Initiation Protocol (SIP) message was old and well known in the art of messaging, therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement Session Initiation Protocol (SIP) message as in Chaddha's method for the purpose of efficiency of setup, modification and tear-down of multimedia communication sessions.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIMON KING whose telephone number is (571)270-1950. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, FAN TSANG can be reached on (571)272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

26 October 2008

/SIMON KING/  
Examiner, Art Unit 2614

/Fan Tsang/  
Supervisory Patent Examiner, Art Unit 2614